

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 15

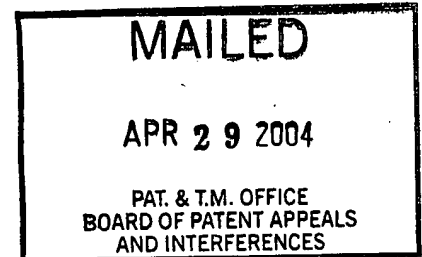
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte BRUNO SCHEUMACHER, SYLVAIN MATTE and LOUIS LEFEBVRE

Appeal No. 2004-1124
Application No. 09/987,202

ON BRIEF



Before ABRAMS, FRANKFORT, and NASE, Administrative Patent Judges.
FRANKFORT, Administrative Patent Judge.

REMAND TO THE EXAMINER

This application is remanded to the examiner under the authority of 37 CFR § 1.196(a) and MPEP § 1211 for action in accordance with the following comments.

The appeal involves claims 1 through 3, 5 through 11 and 15 through 29. Claims 4, 12 through 14 and 30, the only other claims remaining in the application, have been objected to by the examiner as being dependent upon a rejected base claim and

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further indicated to be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims (answer, page 13).

Appellants' invention relates to a snowmobile and, more particularly, to a snowmobile having an engine that is a turbocharged four-stroke engine, which engine appellants indicate on page 1 of their specification has "generally not been used with snowmobiles due to the relatively low power-to-weight/size ratios" of this type engine. Independent claim 1 is representative of the subject matter on appeal and reads as follows:

1. A snowmobile comprising:
a frame;
an engine;
an endless belt drive system;
an air intake system for said engine; and
said frame having a forward portion and an aft portion;
wherein said engine being mounted to said forward portion,
said belt drive system being mounted to said aft portion and
being operatively connected to said engine;
said engine being a turbocharged four-stroke type engine.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Cooper et al. (Cooper)	4,698,761	Oct. 6, 1987
Lakosky	5,598,065	Jan. 28, 1997

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In addition to the above-noted prior art references, the examiner also indicates, on page 3 of the answer, reliance upon information contained in the paragraph spanning pages 1 and 2 of appellants' specification, which disclosure the examiner has referred to as Appellants' Admission of Prior Art (AAPA).¹

Claims 1, 2, 5, 6, 15 through 17, 19 through 21 and 23 through 29 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Lakosky in view of AAPA.

Claims 3, 7 through 11, 18 and 22 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Lakosky in view of AAPA as applied above, and further in view of Cooper.²

¹ Although not specifically listed under the heading "Prior Art of Record" on pages 2-3 of the examiner's answer, we note that the examiner also relies upon appellants' disclosure at page 21, lines 16-18, with regard to a purported admission concerning a continuously variable transmission (CVT) and its ability to reduce or prevent turbo lag being well known in the art of snowmobiles (answer, page 3).

² Although the examiner included claim 30 in the first rejection noted above (answer, page 3), and did not include claim 11 in the second rejection set forth in the answer (page 5), we note that the record (i.e., final rejection and examiner's answer considered together) makes clear that the rejections as we have stated them above are those that are before us for review.

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Looking to the examiner's rejection of claims 1, 2, 5, 6, 15 through 17, 19 through 21 and 23 through 29 under 35 U.S.C. § 103(a) as being unpatentable over Lakosky in view of AAPA, we note that the examiner has asserted (answer, page 3) that Lakosky discloses all of appellants' claimed invention (Figure 1; col. 4, lines 21-23) but does not disclose that a turbocharger or a continuously variable transmission (CVT) is used. To account for these aspects of the claimed subject matter, the examiner urges that AAPA discloses that it is well known to use a turbocharger in conjunction with a four-stroke engine and a CVT in order to increase power output and fuel efficiency of the engine and to reduce or prevent turbo lag (page 2, lines 5-7 and page 21, lines 16-18). From such teachings, the examiner concludes that it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a turbocharger and CVT on the four-stroke engine of the snowmobile in Lakosky as taught by AAPA in order to increase power and fuel efficiency of the engine and to reduce turbo lag. With particular regard to claims 2 and 15-17, the examiner further contends that all of the limitations recited therein are inherent properties of an engine and a turbocharger combination. As for claims 5, 6, 20, 21 and 26-29, the examiner urges that appellants have not disclosed any

criticality to these aspects of the claimed invention and that such would have been obvious since it has been held that rearranging parts of an invention involves only routine skill in the art (citing In re Japikse, 86 USPQ 70):

While we might generally agree with the examiner that it would have been obvious to one of ordinary skill in the art at the time appellants' invention was made to have provided a turbocharger for the four-stroke engine of the snowmobile in Lakosky as taught/suggested by AAPA in order to provide the self-evident advantages of increased power and fuel efficiency for the engine therein, we are at somewhat of a loss to see how this combination alone teaches or suggests the particular arrangement of elements set forth in claim 1 on appeal. More particularly, although Lakosky clearly teaches or suggests a snowmobile with a four-stroke internal combustion engine (col. 4, lines 21-23), we find no details concerning the structure of the snowmobile or the four-stroke engine set forth in this patent. Thus, while it is apparent that; Lakosky generally discloses a snowmobile comprising a frame, an engine, and an endless belt drive system mounted to an aft portion of the snowmobile, we find no disclosure therein concerning "an air intake system for said engine," or any

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teaching that the four-stroke engine provided is necessarily mounted to a forward portion of the frame, as required in claim 1 on appeal. Nor has the examiner clearly provided an explanation of where these aspects of appellants' claimed invention might be found in the applied patent by merely asserting (answer, page 3) that Lakosky "discloses all of Applicants' claimed invention . . . but does not specifically disclose that a turbocharger or a CVT (continuously variable transmission) is used." On REMAND the examiner should account for all of the claimed elements or abandon Lakosky in favor of a reference with a more detailed disclosure.

Like appellants (brief, pages 20-25), we do not see that the examiner has clearly established that the subject matter specifically set forth in claims 2, 5, 6 and 15 through 17 on appeal are necessarily "inherent properties of an engine and a turbocharger," or are somehow accounted for by reliance on In re Japikse, 86 USPQ 70, as presently contended on pages 3-4 of the answer. On REMAND the examiner should review § 2112 of the MPEP and provide a basis in fact and/or technical reasoning to support the determination that each of the specific allegedly inherent features necessarily flows from the teachings of the applied

prior art and is thus necessarily present in the thing described in the applied reference or prior art. In doing so, the examiner must keep in mind that inherency may not be established by probabilities or possibilities, but must instead be "the natural result flowing from the operation as taught" (See In re Oelrich, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981)), and remember that obviousness and inherency are not synonymous.

As a further point, we note that while appellants have apparently conceded that use of a CVT is known in the snowmobile art (specification, page 21), we find nothing therein that necessarily teaches or suggests use of a CVT in combination with a turbocharged, four-stroke engine to assist in preventing turbo lag associated with rapid throttle advancement in such an engine. In addition, while the examiner has asserted that the particular operating requirement set forth in claim 22 on appeal would have been obvious since discovering optimum or workable ranges involves only routine skill in the art, citing In re Aller, 105 USPQ 233, we observe that the examiner has not established the necessary predicate for such a conclusion, i.e., by showing that the prior art in fact discloses the general conditions of the claim and that the variable at issue (here, engine RPM) is

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recognized in the art as a result effective variable in the claimed context of when to allow initial movement of a snowmobile via operation of a CVT. ON REMAND the examiner should clarify his position regarding these aspects of appellants' claimed subject matter.

With respect to the examiner's combination of the snowmobile of Lakosky and the diesel-electric locomotive of Cooper with its means for automatically detecting the presence of the locomotive inside a tunnel and temporarily suppressing the conventional overtemperature-responsive deration function until the coolant temperature rises to a threshold that is higher than the preset overtemperature threshold at which the deration is normally initiated, we do not see that the examiner has in any way responded to appellants' argument on page 33 of the brief that Cooper is "not analogous art" or explained why one skilled in the snowmobile art would have looked to a diesel locomotive in attempting to solve problems related to using a four-stroke turbocharged type engine in a snowmobile. Thus, on REMAND we solicit the examiner's response to these arguments.

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As a further issue, we observe that appellants have claimed priority in their initial declaration to Provisional Application No. 60/247,052 filed November 13, 2000. However, it does not appear that appellants have perfected that priority claim by providing a proper cross-reference to the provisional application in an application data sheet or by having the specification contain or be amended to contain such reference in the first sentence following the title. Thus, appellants are not as of yet entitled to rely on the earlier filing date of the provisional application. Accordingly, on REMAND the examiner should assess the disclosures of the intervening references cited in the Office action mailed November 8, 2002 (Paper No. 4) to determine their relevance to the presently claimed subject matter. In addition, we note that U.S. Patent Nos. 6,390,869 and ~~6~~⁶,415,759 both claim priority to Provisional Application No. 60/185,703 filed February 29, 2000, which date is prior to appellants' earliest possible effective filing date of November 13, 2000. Thus, on REMAND the examiner should assess the disclosure of Provisional Application No. 60/185,703 and determine the prior art effect of the two patents specifically noted above.

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In order to meaningfully contribute to a complete and thorough development of the issues on appeal, it also appears that the examiner should consider a new search of the prior art focussing on Class 123 (Internal Combustion engines) for turbocharged four-stroke engines in particular, and Class 440 (Marine Propulsion), in addition to Class 180, as well as any other classes where relevant prior art would be found concerning the use of four-stroke engines in environments where it was known to use two-stroke engines, e.g., all terrain vehicles (ATV's), lawnmowers, motorcycles, personal watercraft, etc.

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This application, by virtue of its "special" status, requires an immediate action, MPEP § 708.01 (Eighth Edition, Aug. 2001), item (D).

REMAND TO THE EXAMINER

NEAL E. ABRAMS
Administrative Patent Judge

Charles E. Frankfort
CHARLES E. FRANKFORT
Administrative Patent Judge

BOARD OF PATENT
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AND
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